

REMARKS

In the Office Action mailed August 29, 2007 from the United States Patent and Trademark Office, claims 2 and 20 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite, claims 19-25 were rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter, claims 1-8, 12-15, and 18-24 were rejected under 35 U.S.C. § 102(a) as being anticipated by U.S. Patent No. 6,332,149 to Warmus et al. (hereinafter "Warmus"), and claims 9-11, 16, 17, and 25 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Warmus in view of allegedly well-known prior art.

Rejections under 35 U.S.C. § 112, Second Paragraph:

In the Office Action, claims 2 and 20 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. Applicant has amended claims 1-2 and 19-20 so that only a single format is referenced, and submits that the rejections have been overcome. Removal of the rejections is therefore requested.

Rejections under 35 U.S.C. § 101:

In the Office Action, claims 19-25 were rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Applicant has amended the claims in the manner suggested in the Office Action. The claims are now in statutory form, and Applicant respectfully requests removal of the rejections.

Rejections under 35 U.S.C. § 102(a):

Claims 1-8, 12-15, and 18-24 were rejected under 35 U.S.C. § 102(a) as being anticipated by Warmus. M.P.E.P. § 2131 sets forth the standard for a rejection of a claim as anticipated

under 35 U.S.C. § 102. "To anticipate a claim, the reference must teach every element of the claim." M.P.E.P. § 2131 states further,

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). . . . "The identical invention must be shown in as complete detail as is contained in the . . . claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Applicant respectfully submits that the reference cited in the Office Action fails to teach every element of the claim set as provided herein for the following reasons.

Claim 1, as amended, requires: "providing a rendering job of a document as a single file in a native format that supports at least one of (i) multiple pages, and (ii) multiple images," and "storing one or more document indicia as separate sub-images in the single file in the native format." Such limitations are not taught by Warmus. Warmus teaches a method and system for providing combined fixed and variable information on a display device such as a printer, i.e. for printing books that have variable information in them. (See Abstract, Col 6 lines 63-65, Figure 2, for example.) However, the Warmus system does not utilize a single file in a native format that includes the storage of document indicia as separate sub-images in the single file, as is required by claim 1.

Instead, Warmus teaches multiple files, including a file (or set of files) containing the master, fixed data (numbered 120/122), and another file (or set of files) containing data specifying the position of the variable data (numbered 130, 132, 134, 136, 137, 138), and a database that actually includes the variable data (numbered 108). (Figure 5, Col 10 lines 45-67- Col 11 lines 1-30) The multiple files may then be sent to the print system in their separate form. (Col 11 lines 6-9 and 40-44) Warmus teaches that the files may be merged into a single file, but the single file of Warmus is a file that does not contain separate sub-images as is required by

claim 1. (Col 23 lines 26-30 (The master and variable pages are merged.)) Therefore, Warmus fails to teach all limitations of claim 1 and cannot be said to anticipate claim 1.

Independent claims 13 and 19 contain similar limitations and are therefore also allowable over Warmus. All other claims depend from one of claims 1, 13, or 19, and are therefore allowable for at least the same reasons.

Regarding claim 6, while Warmus teaches including multiple objects of variable data on a single page (see Figure 7a), Warmus does not teach sub-chaining sub-images within sub-images as is required by claim 6. For this additional reason, claim 6 is not anticipated by Warmus.

For at least the above reasons, Applicant respectfully requests removal of all rejections under 35 U.S.C. § 102(a).

Rejections under 35 U.S.C. § 103(a):

In the Office Action, claims 9-11, 16, 17, and 25 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Warmus in view of allegedly well-known prior art. M.P.E.P. § 2141 sets forth the *Graham* factual enquiries that should be considered when making an obviousness rejection under Section 103: "Under § 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved." (Citing *Graham v. John Deere*, 383 U.S. 1, 148 USPQ 459 (1966).) Additionally, one helpful standard for a Section 103 rejection is set forth in M.P.E.P 706.02(j), which provides:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or combine reference teachings. Second, there must

be a reasonable expectation of success. Finally, **the prior art reference (or references when combined) must teach or suggest all the claim limitations.** The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaack*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

(Emphasis added). Applicant respectfully submits that the reference cited by the Examiner, does not teach or suggest all the limitations claimed in the claim set provided herein. Applicant also respectfully submits that there is no suggestion or motivation to modify the reference in the manner suggested in the Office Action.

As set forth above, independent claims 1, 13, and 19 include limitations not taught by Warmus, such as those of claim 1: "providing a rendering job of a document as a single file in a native format that supports at least one of (i) multiple pages, and (ii) multiple images," and "storing one or more document indicia as separate sub-images in the single file in the native format." These limitations or similar limitations are contained in the rejected claims by dependency. As the allegedly well-known prior art does not teach such limitations, the claims rejected under Section 103 are non-obvious. For at least this reason, Applicant respectfully requests removal of all rejections under 35 U.S.C. § 103(a).

Regarding claims 10-11, 16-17, and 25, these claims require an underlay process. As acknowledged in the Office Action, Warmus does not disclose an underlay process. However, the Office Action indicates that it is well known in the art to apply an underlay. The motivation for doing so proposed in the Office Action is "to retain the information of the master page of the overlapping region as opposed to the variable page." Applicant respectfully disagrees and traverses the rejection. In particular, the modification proposed in the Office Action would change the function of the Warmus system. The Warmus system relies on delineating the locations where variable data may be included (see 110 and 112 in Figure 6a, and Col 3 lines 36-

39). As Warmus teaches such delineation, no overlapping printing of variable and master data is allowed to occur. Therefore, in the system of Warmus, there is no need to perform an underlay transaction, and to perform an underlay transaction would require significant modification of the Warmus system such that the elements of Warmus would not perform their designed functions.

For at least this additional reason, Applicant respectfully submits that claims 10-11, 16-17, and 25 are not made obvious by Warmus and the allegedly well-known prior art.


Applicant therefore respectfully requests the removal of all rejections under 35 U.S.C. § 103(a).

CONCLUSION

Applicant submits that the amendments made herein do not add new matter and that the claims are now in condition for allowance. Accordingly, Applicant requests favorable reconsideration. If the Examiner has any questions or concerns regarding this communication, the Examiner is invited to call the undersigned.

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Respectfully submitted,


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